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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,869	09/18/2003	Michael G. Polan	CA920020062US1	8469

7590 11/02/2005
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EXAMINER

EL HADY, NABIL M

ART UNIT PAPER NUMBER

2152

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,869

Applicant(s)

POLAN ET AL.

Examiner

Nabil M. El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/18/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-11 are pending in this application.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 7 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer program product defined as computer instructions only is non-statutory. The computer program product should include a computer readable medium with the instructions therein in order for the subject matter to be statutory.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Spencer et al. (US 6,633,907), hereinafter "Spencer"..

6. As to claim 1, Spencer discloses the invention as claimed including a web service provisioning system for provisioning at least one web service (abstract), the provisioning system comprising: a) a subscription system (202, Fig. 2) including: web service description data

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storage for storing web service description data correlated to the at least one web service (col. 1, lines 61-64, and col. 3, lines 55-57), and provisioning processes data storage for storing provisioning processes data correlated to the at least one web service (col. 2, lines 25-28); and b) an invocation system operatively coupled to the subscription system (col. 2, lines 20-24).

7. As to claim 8, the claim is rejected for the same reasons as claim 1 above. In addition, Spencer discloses a method of provisioning at least one web service (abstract), the method comprising the following steps: providing user profile data (col. 1, lines 61-64; and col. 3, lines 55-58); providing web service description data correlated to the at least one web service (col. 2, lines 6-8); providing provisioning processes data correlated to the at least one web service (col. 2, lines 10-12); selecting at least one web service and invoking the provisioning processes data correlated to the selected at least one web service (col. 2, lines 6-11, 21-24).

8. As to claim 2, Spencer discloses a service catalog system configured to select at least one web service (col. 7, lines 52-54).

9. AS to claim 3, Spencer discloses the service catalog system is further configured to determine user profile data (col. 7, lines 59-62).

10. As to claim 4, Spencer discloses a workflow execution engine configured to receive user profile data and provisioning processes data, and wherein the workflow engine is configured to invoke provisioning processes data (Master Object 208, Fig. 2).

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11. As to claims 5 and 9, Spencer discloses the provisioning processes data comprises at least one node, wherein each node comprises web service invocation data correlated to invoking a provisioning web service (SCO, 212, 214, 216, Fig. 2).

12. As to claims 1 and 11, a computer program product having instructions for directing a computer processing system to implement the provisioning system of claim 1 and the method of claim 8 is inherent in Spencer's disclosure.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spenser in view of Applicant Admitted Prior Art, hereafter "AAPA".

15. As to claims 6 and 10, Spencer does not specifically disclose the provisioning processes data comprises WSFL data. However, the standard Web Services Flow Language (WSFL) is well known in the art as indicated by AAPA (Spec. lines 25-27), and It would have been obvious to one skilled in the art at the time of the invention to use it in order to support the composition of web services into business process models.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Chen et al. (US 2004/0034540) ; Hite et al. (US 2003/0036917) ; Atwal et al. (US 2003/0061404); Westerinen et al. (US 2003/0041131); Shay et al. (US 2002/0194045); Mahajan (US 2003/0210657); Fletcher et al. (US 2003/0135628); Schaeck et al. (US 2003/0163513); Mulligan (US 2003/0084177); Robb et al. (US 2003/0120502); and Mulligan et al. (US 2003/0105864).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M. El-Hady whose telephone number is (571) 272-3963. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 26, 2005


Nabil El-Hady, Ph.D, M.B.A.
Primary Examiner
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